

Remarks

Claims 1-31, 36-38, and 45-54 are pending in the application following entry of this Amendment. Claims 32-35 and 39-44 have been canceled. Claims 5 and 8 have been amended. Claims 47-54 have been added. Claims 1, 30, 31, 36, 38, 45, and 46 are the only independent claims pending. No additional claim fee is believed due, because ten claims have been canceled and eight dependent claims have been added.

No new matter is added by the amendments and additions made herein. Support for the amendments to these claims is found in the specification as follows.

"Aminated" has been changed to "amidated" in each of claims 5 and 8 to reflect the more accepted usage of the term. Equivalence of the two terms is disclosed in the specification, for example at page 3, line 15. Amidation is also disclosed in originally-filed claim 29.

Newly added claims 47-54 simply recite a sub-set of the sequences disclosed in the specification (e.g., in originally-filed claim 29).

Restriction Requirement

The Examiner has required restriction among Groups designated I-V in the Restriction Requirement. The Applicants elect **Group I (claims 1-31, 36-38, 45, and 46)**, without traverse.

Second Restriction Requirement

In item 2 of Paper No. 6, the Examiner indicated that if Group I were elected for prosecution on the merits, than a further restriction requirement would be applied, restricting the examined claims to a single compound disclosed in dependent claim 29. The Applicants elect the compound having the sequence SEQ ID NO: 4, but strongly traverse this second purported restriction requirement, for at least two reasons.

First, the Applicants respectfully contend that the Examiner does not appreciate the breadth of the invention that the Applicants have made. They have invented using substantially any insect adipokinetic hormone (AKH) to promote lipid mobilization in a human.

The Examiner asserts that the invention must be limited to use of a single AKH. This assertion simply ignores the nature of the invention. Every insect AKH that the Applicants have tested exhibits lipid mobilizing activity. Useful AKHs include not only the 40 known AKHs (from 39 different insects - see Tables 2 and 3 in the specification), but also all other known insect AKHs and insect AKHs that have not yet been discovered. Limiting the invention to a single AKH expressed in one or a few insect species ignores the contribution that the Applicants have made to knowledge in this field.

Second, the Examiner's proposed second restriction requirement is inconsistent with the rules set forth in the MPEP. The Applicants believe that different rules apply to independent claims 1, 36, 38, 45, and 46 (and their dependent claims) than to independent claims 30 and 31 (and their dependent claims). For this reason, the Applicants discuss these two groups of claims separately below.

Independent Claims 1, 36, 38, 45, and 46

The MPEP (§ 803 "**Restriction - When Proper**") states that, "*If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions*" (emphasis added).

In this application, every embodiment recited in independent claims 1, 36, 38, 45, and 46 includes administration to a human of an insect AKH. Thus, the only search that the examiner needs to do with regard to this element of claims 1, 36, 38, 45, and 46 and claims (2-29, 37, and 47-50) depending therefrom is a search relating to insect AKHs. The Examiner need not search every particular species disclosed in the specification (or in claim 29) in order to consider the patentability of independent claims 1, 36, 38, 45, and 46 and their dependent claims, nor need the Examiner discover, sequence, and search the literature for uses of as-yet undiscovered insect AKHs. Because the Examiner can search and examine claims 1-29, 36-38, and 45-50 without serious burden, the Examiner must examine those claims on the merits, even if dependent claim 29 may include independent or distinct inventions.

Independent Claims 30 and 31

Each of independent claims 30 and 31 recites methods involving administration of a compound (i.e., not necessarily an insect AKH) having a common structure. The common structure is recited in the independent claim, as are allowable variations. Using these formulas, the Examiner is enabled to search the literature (e.g., using sequence-searching algorithms that permit specification of variable sequence positions). Thus, the Examiner need not independently search each of the 40 sequences disclosed in the specification. Because the Examiner can perform a search of all of the subject matter recited in independent claims 30 and 31 and the claims (51-54) depending therefrom simply by searching the formulas recited in the independent claims, the Examiner must not restrict every species within those claims. For the Examiner's convenience, the Applicants suggest that the Examiner may wish to consider the restriction requirement to be an election of species requirement with regard to independent claims 30 and 31. If so, each of claims 30, 31 and 51-54 appear to correspond to elected species SEQ ID NO: 4.

Summary

In summary, Group I is elected without traverse and SEQ ID NO: 4 is provisionally elected. The Examiner is strongly urged not to restrict claims 1-29, 36-38, and 45-50. The Examiner is also urged to consider election of SEQ ID NO: 4 to be a species election with respect to claims 30, 31, and 51-54.

Should the Examiner believe that this Response is deficient in any way, the Examiner is requested to immediately contact the undersigned representative by telephone.

Early and favorable examination of

- i) elected claims 1-29, 36-38, and 45-50 throughout their scope and
- ii) elected claims 30, 31, and 51-54 as they relate to elected species SEQ

ID NO: 4

are respectfully requested at the earliest possible time.

Respectfully submitted,

BERNICE SCHACTER ET AL.

25 August 2003
(Date)

By: 

GARY D. COLBY, Ph.D., J.D.

Registration No. 40,961

Customer No. 08933

DUANE MORRIS LLP

One Liberty Place

Philadelphia, PA 19103-7396

Telephone: 215-979-1000

Direct Dial: 215-979-1849

Facsimile: 215-979-1020

E-Mail: GDColby@DuaneMorris.com

Enclosures: Petition for a Three-Month Extension of Time